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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/456,371	12/08/1999	HEINRICH BOLLMANN	12010	6395

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BASF CORPORATION  
LEGAL DEPARTMENT  
1609 BIDDLE AVENUE  
WYANDOTTE, MI 48192

EXAMINER

CHANG, VICTOR S

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 05/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/456,371

Applicant(s)

BOLLMANN ET AL.

Examiner

Victor S Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19,20,22,23 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19,20,22,23 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The Examiner has carefully considered Applicants' amendments and remarks filed on 4/7/2004. Applicants' amendments to claims 19 and 30, cancellation of claims 1, 24 and 29 have all been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.

### ***Claim Objections***

4. Claim 19 is objected to because of the following informalities:

In claim 19, lines 10-12, the recitation "of the transverse link, the longitudinal link, the triangular link, the rear-axle subframe, the stabilizer, the spring-strut support, or shock absorber" is clearly a duplicate of the recitation in preamble. The Examiner suggests that deletion is proper.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 19, 20, 22, 23 and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains

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subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

More particularly, in claim 19, line 7, the newly added term "chemically" appears to be "new matter", because Applicants have not pointed out any express or inherent support in the specification that the bonding is "chemically" formed. Proper support or deletion is required.

### ***Response to Amendment***

7. Claims 19, 20, 22, 23 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bauvois (US 5288442), substantially for the reasons set forth in section 6 of Paper No. 121803, together with the following additional observations.

Applicants' argument that "Bauvois generally discloses a foam core ... a polyurethane foam ... There is no teaching, suggestion, or motivation in Bauvois to form the expandable foam core from a microcellular polyurethane elastomer as claimed in the present claim" (Remarks, pages 4-5, bridging paragraph) has been carefully considered, but is not persuasive. The Examiner notes that Bauvois teaches essentially the same polyurethane foaming process and the same damping applications of the instant invention. As such, a suitable microporous foam structure is believed to be either implicitly taught by Bauvois' polyurethane foam for damping elements, or an obvious optimization to one of ordinary skill in the art, motivated by the desire to provide required damping properties. Note also as evidence of the state of the art Krech (US

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6063824), which was previously cited (see Paper No. 14, page 3) as teaching a microcellular polyurethane elastomer for a vibration and shock damping system, which has a density, tensile strength, elongation at break and tear propagation resistance within the ranges of the instantly claimed element.

With respect to Applicants' response arguing that "Bauvois teaches forming the core from an expandable material ... the expanded foam core does not adhere to the deformable tubular TPU element, otherwise the deformable tubular TPU element would not force the rigid plate against the shell to form the shape of the mold" (Remarks, page 5), the Examiner notes that Applicants' argument lacks evidentiary support, and Attorney arguments cannot take the place of evidence. MPEP § 7160.1(c). Further, the Examiner repeats (see Paper No. 121803, page 3) that Bauvois' invention is directed to a process for the manufacture of a molded structure, which comprises stiffening or reinforcing elements and/or various mechanical elements such as, for example, damping elements, lightening elements, etc. (column 1, lines 7-20). Since Bauvois' invention clearly teaches essentially the same process for forming the damping element as the instantly claimed invention, the resulting adhesion between the TPU element and the microporous polyurethane foam is believed to be also inherently the same, whether it is chemically bonded or not.

Applicants' argument that "There is no teaching, suggestion, or motivation to use the damping element in the transverse link, the longitudinal link, the triangular link, the rear-axle subframe, the stabilizer, the spring-strut support, or the shock-absorber. One skilled in the art attempting to replace a rubber-metal damping element in any one of

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these recited structures would not have relied on technology relating to a process for making ski\$. Therefore, Bauvois teaches away from using a microcellular polyurethane elastomer ..." (Remarks, page 6, top paragraph) has been carefully considered, but is not persuasive. The Examiner repeats that Bauvois' invention is directed to a process for the manufacture of a molded structure, which comprises stiffening or reinforcing elements and/or various mechanical elements, including damping elements, as set forth above. Nowhere does Bauvois disclose\$ that the molding process is limited to making ski\$. Applicants' argument to the contrary notwithstanding.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1900-  
1700

*Daniel Zinker*